

AF 13728

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*Jennifer O. Ahearn*  
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**PATENT**  
Atty. Docket No. 31045-7

#27  
Reply  
Brief  
E. J. Fajardo  
10/8/03

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

ALBERT SILVERA

Serial No.: 09/268,412

Filed: March 15, 1999

For: TECHNIQUE FOR DECORATING A SHOE  
AND A SHOE DECORATED USING THE  
TECHNIQUE

Group Art Unit: 3728

Examiner: J. Mohandesi

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**APPELLANT'S REPLY BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following remarks respond to the Examiner's Answer, which was filed on  
July 28, 2003 in the above-referenced case.

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At the outset, it is noted that the Examiner has, for the most part, simply repeated the same grounds for the rejections that were set forth in the final Office Action. In doing so, the Examiner has failed to respond to most, if not all, of the specific points that were raised in Appellant's Appeal Brief.

The following remarks briefly summarize some of the arguments that were made in the Appeal Brief and address the Examiner's responses to such remarks, with respect to the Group 1 claims only. Similar remarks can be made in connection with each of the other groups of claims. However, for the sake of brevity, Appellant will not repeat arguments already made in the Appeal Brief in connection with such other groups.

In the Appeal Brief, Appellant pointed out that the two applied references are directed to two entirely different decorative articles: an adhesive-backed rhinestone that probably can adhere to nearly any surface (Creative Crystal) and a non-adhesive-backed film-like tattoo that is intended for application to a wearer's skin (SkinWear). Based on these differences, Appellant argued that Creative Crystal's teaching to apply adhesive-backed rhinestones to a shoe could not properly have been combined with SkinWear's mere disclosure of a non-adhesive-backed skin tattoo in any manner that would have motivated one of ordinary skill in the art to attempt to attach a SkinWear tattoo to a shoe.

Responding to these arguments, the Examiner has merely repeated the unsupported conclusion that "the use of SkinWear type artificial tattoo is an obvious alternative, readily available to the ordinary skilled worker." Such an assertion is similar

to the assertion that was made by the patent examiner, and subsequently rejected, in the Federal Circuit case *In re Lee*, 277 F.3d 1338, 1343-44 (2002):

The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. "This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 312-13 (Fed. Cir. 1983).

There, the Federal Circuit also held:

The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

*Id.* at 1342-3.

Here, the only evidence was presented by Appellant and indicates that there would not have been any motivation to select and combine the applied art references in the manner suggested by the Examiner.

In fact the Examiner's entire argument seems to focus upon the fact that the Creative Crystal reference chose to describe its product, in certain places, as "Crystal Tattoos". However, such reliance on this mere choice of description ignores the fact that the products in the two applied art references are, in construction and appearance, fundamentally different from each other. As pointed out in the Appeal Brief, the

Creative Crystal product is not a "tattoo" at all, according to any ordinary understanding of that word.

Similarly, the Appeal Brief pointed out, and presented evidence showing, that the applied art would not lead one of ordinary skill in the art to have any expectation of success in combining the applied art references in the manner suggested by the Examiner. The Examiner has presented nothing to refute this assertion and corresponding evidence, other than the Examiner's subjective belief that a sixth grader would have the skill to find the proper surface by trial and error.

Level of skill, however, is not the appropriate question. Rather, the correct inquiry with respect to this factor is whether an individual would have sufficient reasonable expectation of success to first embark upon, and then continue with, such a trial-and-error process until a solution is found. Once again, the Examiner has not alleged such reasonable expectation of success or attempted to refute the Appellant's statements and evidence in this regard.

Based on the foregoing remarks and the arguments presented in the Appeal Brief, it continues to appear that one of ordinary skill in the art would not have had either the motivation to combine the applied art references in the manner asserted by the Examiner or any reasonable expectation of success in doing so. Therefore, Appellant continues to believe that the present rejections should be reversed and a Notice of Allowance issued.

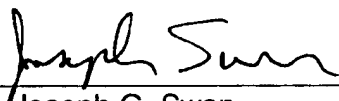
Serial No. 09/268,412

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Respectfully submitted,

**MITCHELL, SILBERBERG & KNUPP LLP**

Dated: September 29, 2003

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